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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,983	11/03/2003	Anthony B. Eoga	PA00-1010-CIP-A	5318

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EXAMINER

ANTHONY. JOSEPH DAVID

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 03/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/699,983

Applicant(s)

EOGA, ANTHONY B.

Examiner

Joseph D. Anthony

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5,6 and 8-18 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,6,8-10, 12-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

FINAL REJECTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 3, 5-6, 8-10, and 12-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Newly added step "c." which reads "**removing unbound composition** by applying an aqueous solution to the coated surface", [emphasis added] as set forth in independent claim 1 contains New Matter. In applicant's REMARKS section applicant asserts that no new matter was introduced by the claim amendments, and refers the examiner to page 6, line 1 and page 13, line 16 of the parent application 09/751,160 for support. Since the present application is a divisional of the parent application the specifications should be identical. When the examiner looked at the cited pages and line numbers of applicant's said parent application, there was found absolutely no support for applicant' newly added step "c." A look at the rest of the specification also turned up no support for applicant's newly added step "c."

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 5-6, 8 and 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roth et al. U.S. patent Number 5,418,006.

Roth et al disclose a method for coating a substrate surface with an aqueous composition comprising from 0.1 to 20% by weight, and in particular from 1.0 to 10% by weight of a film-forming substance, a water repelling substance and optional adjuvants such as surfactant. The coating can be removed with water and can be used to protect the coated surface from graffiti, see the abstract, column 2, line 23 to column 4, line 3, column 6, line 37 to column 7, line 6, examples, and claims. Preferred film-forming substances can be selected from many different polymeric materials of which polyethylene glycol and derivatives are directly listed, see column 2, line 68 to column 3, line 1.

Roth et al differ from applicant's claimed invention in the following ways: 1) there is no direct teaching (i.e. by way of an example) to a process of coating a surface using a solution that comprises: a) polyethylene oxide having a molecular weight greater than about 100,000 in water and b) a surfactant., 2) there is no literal statement within Roth et al's disclosure to applicant's newly added step of

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"removing unbound composition, by applying an aqueous solution to the coated surface" as set forth in independent claim 1., and 3) there is no direct teaching (i.e. by way of an example) to wherein said coating solution further comprises a paint (e.g. a dye) or at least one antimicrobial agent, as set forth in new claims 17-18.

It would have been obvious to one having ordinary skill in the art to use the broad disclosure of Roth et al as strong motivation to actually use polyethylene oxide as the film-forming substance in the aqueous coating solutions since such a film-forming substance is directly suggested by Roth et al at column 2, line 68 to column 3, line 1 as a preferred film-forming substance according to the invention.

In regards to Roth et al's lack of a literal statement to applicant's newly added step of: "removing unbound composition, by applying an aqueous solution to the coated surface" as set forth in independent claim 1, such is deemed to occur by necessity when Roth et al's film coating is willfully removed after it has been soiled, by dust, graffiti etc.. Furthermore, since Roth et al. film-forming solutions are applied to exterior surfaces to protect them from graffiti, and these exterior surfaces are exposed to rain and other weather phenomena, the unbound composition would be removed by such means prior to a person willful removing the film coating from the surface.

Finally, it would have been obvious to one having ordinary skill in the art to add paint (e.g. a dye) and an antimicrobial agent to the aqueous coating solution since such additions are directly claimed by Roth et al in claim 7.

5. Claims 1, 3, 5-6, 8-10, and 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sramek U.S. Patent Number 4,861,583.

Sramek teaches aqueous hot curling hair treatment compositions that comprise water and at least 1% by weight of a water soluble polyethylene oxide polymer that have a molecular weight between about 20,000 to about 250,000. After applying the composition the hair is dried and curled with a hot curling iron. The polymer can be washed out of the hair at anytime to allow for changes in style, see abstract, column 3, lines 30-57 and claim 1. Optional adjuvants are surfactants, wetting agents, dyes, perfumes, conditioning agents such as fatty quaternary ammonium compounds or amine salts etc., see column 3, lines 30-61. Sramek differs from applicant's claimed invention in the following ways: 1) there is no direct teaching (i.e. by way of an example) to a process of coating a surface using an aqueous solution that comprises: a) polyethylene oxide having a molecular weight greater than about 100,000 and b) a surfactant., 2) there is no literal statement within Sramek's disclosure to applicant's newly added step of "removing unbound composition, by applying an aqueous solution to the coated surface" as set forth in independent claim 1., and 3) there is no direct teaching (i.e. by way of an example) to wherein said coating solution comprises

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polyethylene oxide having a molecular weight greater than about 100,000 and further comprises a paint (e.g. a dye) or at least one antimicrobial agent, as set forth in new claims 17-18.

It would have been obvious to one having ordinary skill in the art to use the broad disclosure of Sramek as strong motivation to actually use a surfactant component in combination with a polyethylene oxide component having a molecular weight greater than about 100,000 in the aqueous hair treating compositions. This is obvious because Sramek direct teaches in examples 7-10 the combination of a surfactant component (e.g. TETRONIC 1508) in combination with a polyethylene oxide having a molecular weight of about 88,000 (e.g. U.C. POLYOX WSR-N10). It would thus have been obvious to employ U.C. POLYOX WSR N-3000 (i.e. polyethylene oxide having an average molecular weigh of 616,000) in leu of U.C. POLYOX WSR-N10 since U.C. POLYOX WSR N-3000 is directly taught by Sramek in Example 15 and the patent teaches the interchangeability of all the listed polyethylene oxide components, see column 7, lines 3-28.

In regards to Sramek lack of a literal statement to applicant's newly added step of: "removing unbound composition, by applying an aqueous solution to the coated surface" as set forth in independent claim 1, such is deemed to occur by necessity when Sramek hair coating is removed after it has become soiled or there is a desire on the user part to change hair styles.

Finally, it would have been obvious to one having ordinary skill in the art to add paint (e.g. a dye) and an antimicrobial agent to the aqueous coating solution since such additions are directly disclosed by Sramek in column 3, lines 58-61 and Example 1 wherein Cetrimonium chloride is used which is a compound that is well known to have effective antimicrobial properties.

Please note that since external hair is non-living tissue on which the hair treatment composition is being applied, the Sramek method is deemed to read on applicant's claimed inanimate surface. Likewise, the taught applying step would result in some of the hair treatment composition contacting the persons scalp which is human skin and thus reads on applicant's claimed animate surface.

Claim Objections

6. Claim 17 is objected to because of the following informalities: In line 1 of the claim the phrase "step a" would be made more clear if it were rewritten as --step (a)--. . . Appropriate correction is required.

Response to Arguments

7. Applicant's arguments filed 12/20/2004 with the amendment have been fully considered but are not persuasive to put the application in condition for allowance for the reasons set forth above. Additional examiner comments are set forth now. The previously applied Murayama patent has been dropped, since in part it does not really teach applicant's step of drying the coated surface.

In the REMARKS section of applicant's response applicant asserts that the applied Roth et al patent teaches away from applicant's claimed process since Roth et al teaches a pre-requisite impregnation step of the surface prior to applying the film-forming coating, and a post-impregnation step of the surface after applying the film-forming coating. The holds that both of these steps of Roth et al do not in any way make for a patentable distinct between applicant's claimed invention and that of Roth et al. In the first place applicant's independent claim 1 uses the open claim language of "comprising" in line 1 of preamble of the claim which opens up applicant's claims to all additional method steps as long as the list steps are also present. As such, Roth et al's additional process steps are in no way excluded from applicant's pending claims. Furthermore, applicant's contention that Roth et al' post-impregnation step renders the surface water-repellent and thus teaches away from applicant's claimed invention is not true. Applicant's attention is drawn to Roth et al's column 6, line 67 to column 7, line 11, as well as the examples, wherein Roth et al make it very clear that a post-impregnated coated substrate can have its coatings removed with a water solvent.

In regards to the applied Sramek patent, applicant argues that Sramek does not have a teaching to removing the coating at room temperature. This position of applicant's is false. Sramek makes it super clear throughout the patent that the hair coating compositions are removed from the hair with water as a solvent, see column 3, lines 56-57.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

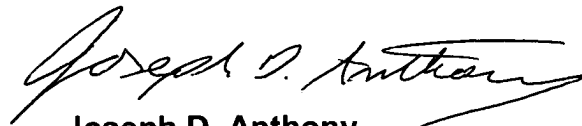
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Examiner Information

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (571) 272-1117. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The centralized FAX machine number is (703) 872-9306. All other papers received by FAX will be

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treated as Official communications and cannot be immediately handled by the
Examiner.



Joseph D. Anthony
Primary Patent Examiner
Art Unit 1714

3/8/05